

REMARKS

The last Office Action of February 15, 2006 has been carefully considered.

It is noted that these claims were rejected under 35 U.S.C. 103(a) over the patent to Chaudoreille.

Also, the drawings and the claims were objected to.

In connection with the Examiner's objection to the drawings, applicants provided replacement sheet of Figure 1 with the corresponding cross-hatching.

It is believed that the Examiner's grounds to the objection to the drawings should be considered as no longer tenable and should be withdrawn.

The Examiner's objection to claim 1 was caused probably by a faxed transmission, since in the current claim 1 the corresponding units have been presented correctly.

After carefully considering the Examiner's grounds for the rejection of the claims over the art, applicants have amended claim 1 and submitted two new independent claims 15 and 16.

It is respectfully submitted that claims 1, 15 and 16 clearly and patentably distinguish the present invention from the prior art applied by the Examiner.

Turning now to the references and in particular to the patent to Chaudoreille, it is respectfully submitted that this reference discloses a cover element 20 which is not a connection element and is used to close off the cavity 14 of the bearing and not to ensure a releasable connection of an electric motor (not alternator) with a machine or a machine part, since the element 14 of the reference is not a machine or a machine part but instead it carries diodes and it is an electronic device. If one intends to separate parts 34 from part 10 this can be accomplished by a part 20 since all parts 34, 20 and 10 are mounted together by a bolt in the reference. It is not possible to release part 34 from part 20 independent from parts 20, and in addition part 34 is not driven by part 20 since part 20 is not a motor and part 34 is a fixed part and can not be moved.

The cover plate 20 covers a first abutment and a second abutment (10 and 34 correspondingly), and the first abutment is covered

by a sealing gasket 22, which is a detachable part and not a non-detachable thin, metallic coating. The sealing gasket 22 is used to ensure a sealant between the cover plate 20 and the bearing 10 because of the use of coolant liquid inside the cavity of the bearing.

In contrast, the coating or hard coat provided in the present invention is a non-detachable coating and is a component of the connection element surface. It is not formed as a separable gasket attachable to the abutment surface.

It is therefore believed that the sealing gasket 22 disclosed in the patent to Chaudoreille can not be compared with the non-detachable thin metallic hard coating of the present invention, which is not a gasket attachable to and separable from the abutment surface.

Claim 15 additionally defines that the coating of the applicant's invention is non-detachable fluid-bath applied coating which is applied on and non detachably connected with the abutment surface. The features of claim 15 are not disclosed in the references and can not be derived from it as a matter of obviousness.

Claim 16 additionally defines that the coating is also applied in threaded openings of the connection element. The patent to

Chaudoreille does not disclose this feature at all, and it does not contain any hint or suggestion for this feature.

It should be also emphasized that the structural differences between the connection element of the present invention and the element disclosed in the patent to Chaudoreille as now defined in claims 1, 15 and 16 result from a totally different object of the present invention in the reference. One object of the present invention is to avoid heat transfer from the electric motor to a machine driven by this motor, with the motor mounted on the machine. To avoid this type of heat transfer, the connecting element between the motor and the machine must be configured in a special manner so that it carries a little feed as possible from the motor to the machine.

In contrast, in the patent to Chaudoreille the sealing gasket 22 is composed of copper which is a very good thermal conductor. Therefore the object of the present invention is exactly opposite to the teaching of the patent to Chaudoreille, or in other words the patent to Chaudoreille teaches away from the present invention. The object of the patent to Chaudoreille is to improve the cooling effect or in other words to include heat transfer instead of blocking the heat transfer of the components of the current regulating means and to explain in column 1, line 61-66, and

therefore the patent to Chaudoreille presents a solution to optimize the heat transfer between parts 34 and part 10 via the liquid cooling.

The original claims were rejected over the patent to Chaudoreille as being obvious. It is believed that it was clearly demonstrated above that the reference does not contain any hint or suggestion for the feature new features of the present invention as defined in claims 1, 15 and 16. In order to arrive at the applicant's invention from the teaching of the reference, the reference has to be fundamentally modified by including into it the new features of the present invention which were first proposed by applicant. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in *re Randol and Redford* (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Also, as explained herein above, the present invention provides for the highly advantageous results which can not be accomplished by the construction disclosed in the advantages results.

Also, as explained herein above, the reference also teaches away from the applicant's invention. As decided in *re Gruley*, 31 USPQ 1130-1131 (Fed. Cir. 1994):

"A reference may be said to teach away when a person of ordinary skill upon reading the reference, would be discouraged from following the path set out of the reference, or would be letting the direction diverging from the path that was taken by the applicant".

Definitely, the decision is applicable for the present application.

In view of the above presented remarks and amendments, it is believed that claims 1, 15 and 16 should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on claim 1, they share its presumably allowable feature, and therefore they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully submitted.

Should the Examiner require or consider it advisable that the

specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



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